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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,962	08/24/2001	Laurence Victor Marks	RAL920000102US1	2139
25299	7590	05/18/2005	EXAMINER	
IBM CORPORATION PO BOX 12195 DEPT 9CCA, BLDG 002 RESEARCH TRIANGLE PARK, NC 27709			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/938,962	Applicant(s) MARKS, LAURENCE VICTOR	
	Examiner James H Zurita	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-14 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-14 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

On 31 January 2005, applicant cancelled claims 9 and 15, amended claims 1-7, 10, 12, 13 and 16, and added claims 19-25.

Claims 1-8, 10-14, 16-25 are pending.

Specification

The amendment filed 31 January 2005 is objected to under 35 U.S.C. 132(a) because it introduces ***new matter*** into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

It is yet still a further object of the invention to permit the merchant to aggregate purchases made under all information sets of each user. The aggregation of purchases makes the user eligible for volume discount or rebate offered by the merchant.

Figures 12-14 illustrate database records used in the aggregation of purchases.

FIGURES 12-14 are database structures or records provided in the database. FIGURE 12 illustrates how the various information sets are stored in the database. Shown are information sets for the customer whose information sets are displayed in FIGURE 7. Information sets are indexed by customer number, so all the information sets may be displayed to the customer for his selection. They contain the customer's complete credit card number, although that information is not displayed. When the customer checks out, this information is accessed to prepare the display shown in FIGURE 7. This information is modified if the user elects to create, edit, or delete an information set. FIGURE 13 illustrates how the customer purchase information is stored in the database. It is also indexed by customer number. Illustrated is the purchase shown in FIGURE 7 as well as a later purchase. Each purchase record indicates which information set was used for the purchase. To keep the records brief, purchased items are identified by their stock numbers, written under the heading "Item", rather than textual descriptions displayed to the customer as shown in FIGURE 7. This database can be used for inquiries regarding purchases, aggregation and for preparing credit card customer inquiry charges.

The database segment shown in FIGURE 14 is used to associate text descriptions with item stock numbers. Illustrated are the items shown which appear in FIGURE 13. It is advantageous to index the records by customer number as shown in FIGURE 13 because this permits easy access to all of the customer's purchase history, regardless

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of which information set is used. For example, the merchant could access the database to determine all the purchases made by each customer in the past year, by summing all records (expanding price times quantity) with the same customer number, to apply volume discounts or rebates, or to make special offers. This would not be possible if the user created independent identities with separate customer numbers.

Applicant argues, page 17, lines 1-3, that the above is not new matter:

Figures 12-14 are database structures or records used for aggregation which is disclosed in the specification at col. 5, lines 1-2. In addition, these figures and descriptions relate to Figure 7 and as such are not deemed to be new matter.

The Examiner respectfully disagrees. Applicant's reference to Col. 5, lines 1-2 appears to be an error, and will be interpreted to refer to page 5, lines 1-2 of the original specification, reflected as emphasized text below:

In some cases, the information shown on FIGURE 6 might be shown before FIGURE 5. The user will not place an incorrect order in this case, but will find himself forced to delete and re-enter information that has changed. In some cases, where the new information is temporary (sending a gift for example), the user will have to re-enter the normal information later. The buyer may get around this problem by creating multiple accounts at each on-line merchant, but this has its own difficulties. The user must keep track of which account is which, and he will be unable to group his purchases to take advantage of volume discounts or rebates.

[Ex. Note: paragraph 39 in PG-PUB, page 4, line 20-page 5, line 2, in the original specification filed 24 August 2001]

However, applicant does not appear to provide a solution to this observed problem and attempts to do so via this new matter. Even if applicant can be found to have recognized a problem, it cannot be said that applicant has solved it.

Applicant is required to cancel the new matter in the reply to this Office Action.

Fig. 9 step 922 reads "remove item[n] from order. Redisplay order page with remaining items." Steps 920 and 922 pertain to removing order items from a shopping cart. Step 922 is described on page 10, lines 18-25 (paragraph 42 of PG-PUB). Again, to correct this error, the Examiner suggests changing the text to match Fig. 9, step 922 **from**

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...This will look similar to the screen he was viewing, except that one line of address and credit card data will have been deleted...

to

...This will look similar to the screen he was viewing, except that one line of the order [shopping cart] will have been removed...

Appropriate correction is required.

Claim Objections

The following claims are objected to because of informalities:

Claims 1-6, 10, 11-12 and 17-18 refer to various types of "...screens..." that are not described in the specifications, although the Abstract mentions a "...multi level order entry screen..." For example, Claims 1, 3, 4, 6, 10, 12, 16 and 18 refer to a "...control screen..." that appears to correspond to applicant's Fig. 7. Claims 2, 3, 5, 6, 11, 12, 17 and 18 refer to a "...parameter entry input screen..." that appears to correspond to prior art in Figs. 3 and 4. The descriptive labels impart little patentable moment in distinguishing the instant claims from prior art. For purposes of applying prior art, the various types of "...screens..." will be given their broadest reasonable interpretation to read on a first screen and a second screen.

Claims 1, 3, 4, 6, 10, 12, 16 and 18 refer to various "...entry means..." that are not described in the specifications. For example, Claims 1 and 16 refer to a "...user controlled data entry means..." Claims 4 and 10 refer to a "...user controlled order entry means..." Claims 4, 6, 10 and 12 refer to a "...order entry means..." Claims 1, 3, 16 and 18 refer to a "...data entry means..." The descriptive material imparts little patentable moment in distinguishing the instant claims from prior art. For purposes of

applying prior art, the various "...entry means..." will be given their broadest reasonable interpretation to read on a client on a network.

Claims 1, 4, 8, 10, 14, 16 refer to "parameters unique" to a user and "unique parameters" in the profile field. The specification does not provide a standard for ascertaining a requisite degree of uniqueness. For purposes of this examination, the terms will be given their broadest reasonable interpretation to include a record that contains information concerning a user.

Claims 1, 4, 10 and 16 refer to "...data for defining a [first] screen..." The first screen (Fig. 7), when displayed, contains **(a)** information from a user profile field that has a plurality of parameters, such as billing, shipping information, as in prior art Figs.3-4 **(b)** button fields for adding, deleting and updating the plurality of parameters found in a selected user profile, **(c)** fields for displaying shopping cart information and **(d)** a button field for removing an item from a shopping cart. Items (b), (c) and (d) **are not** part of a user profile or a user profile field in applicant's invention. However, claims 7, 8, 13, 14 appear to claim otherwise:

...said at least one profile field includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action. (claims 7 and 13)

...user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field. (claims 8, 14)

...unique parameters in the profile field include a credit card number sub-field, a ship to address sub-field and a bill to address sub-field. (claims 9, 15)

Consistent with the disclosures, the Examiner will interpret user profile and user profile field as synonyms that **exclude** (claims 8, 14) "user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field

requesting an edit of the unique parameters and a third user selectable sub-field
requesting deletion of the profile field.”

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. For example, the claims refer to aggregation, indexing, rewards, which are not mentioned in the original filings.

Claims 19-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, the claims refer to aggregation, indexing, rewards, which are not mentioned in the original filings.

Claims 1, 4, 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's amendment added the limitation concerning displayed two profile fields, each including a credit card number sub-field, a ship to address sub-field and a bill-to address sub-field wherein each sub-field is unique to the user and selectable by said user. Fig. 7 shows specific examples where the data to be displayed in each of the sub-fields is not unique to a user. For example, Applicant has not explained how one would apply his limitation. Applicant has not shown that user Marks is the only person at the various IBM addresses.

Claims 1, 4, 10 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Fig. 7 shows specific examples where the data to be displayed in each of the sub-fields is not unique to a user. For example, Applicant has not explained how one would apply his limitation. Applicant has not shown that user Marks is the only person at the various IBM addresses.

Claims 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, the term user customer number lacks antecedent.

In claim 19, the term "...indexing into the database record with said single parameter..." is not clear, since indexing refers to a database, not to a specific record.

In claim 19, the term "...aggregating parameters of items ..." is indefinite since parameters of items may include data that may not be aggregated, such as a parameter that contains description of an item and a parameter that contains price information.

The term parameter in claims 19-24 is indefinite. The claims refer to various parameters, including:

1. Single parameter [unique to a user]
2. Parameters describing items purchased by said user
3. Parameters of items associated with said single parameter
4. Parameters aggregated

It is not clear whether terms 2 and 3 are used interchangeably and what fields are aggregated into aggregated parameters.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson (US 5794396).

As per claims 19, Anderson discloses methods for conducting e-commerce;

- **providing** in a database stored in memory of a network server a database record including a single parameter unique to a user and parameters describing items purchased by said user. See, for example, at least pp12, Fig. 7, 11 and related text. see also references to repositories, Fig. 7 and related text.
- **indexing** into the database record with said single parameter. See at least references to identifier for uniquely identifying a consumer, as in claim 30. see also Col. 22, lines 1-67, concerning unique membership identification number (MIN).
- **aggregating** the parameters of items associated with said single parameter and purchase by said user. See, for example,

As per claim 20, Anderson discloses that the single parameter unique to a user includes the user customer number. See, for example, references to signing up and assigning a unique membership identification number (MIN), as in Fig. 4 and related text.

As per claim 21, Anderson discloses that parameters describing items purchased by said user may include quantity purchased, item identification number and price information. See at least references to UPC codes, and product cluster purchases, as in Col. 23, line 30-Col. 24, line 14.

As per claim 22, Anderson discloses that parameters aggregated may include prices of items purchased. See, for example, at least Col. 22, lines 5-10.

As per claim 23, Anderson discloses that parameters aggregated may include quantity. See at least Col. 22, lines 5-25.

As per claim 24, Anderson discloses that the method of claim 19 may further include a database record storing reward information; correlating aggregation of the parameters with the reward information; and awarding the reward to the user if the aggregation meets terms of the reward information. Please see references to product promotions stored in relational databases, including totals for a customer. See also references to points accumulated and rewards base on points, as in Col. 1, lines 53-Col. 3, line 17.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-8, 10-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat (US 6,459,499).

Tomat discloses data entry means. See Fig. 4 and related text.

- Storing data see, for example, at least Col. 3, lines 16-21.
- generating and transmitting the generated control screen to the data entry means via the communication system. See, for example, at least Fig. 4 and related text.

Tomat does not specifically disclose the environment described in the preamble

...which includes a central accounting system, a plurality of user controlled data entry means and a communication system for connecting the data entry means to the central accounting system...

However, this language carries little patentable weight.

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Tomat does not specifically disclose that the data is

... for defining a control screen which includes

- at least two profile fields which includes a plurality of parameters unique to the user, each one including a credit card number sub-field, a ship to address sub-field and a bill-to address sub-field wherein each sub-field is unique to the user and selectable by said user;
- a field for indicating, when selected by the user, the need to create an additional profile field containing different parameters unique to the requesting user;

The Examiner notes that presentation of data on a screen is old and well known and that data may be presented in a variety of formats on a user interface. Since the data has no function as claimed, the information is a compilation or mere arrangement of data. See MPEP 2106, pp. 2100-11 and 2100-12. The display of information is related to precedents dealing with printed matter, i.e., presentation of information in a form that is useful and intelligible only to the human mind. See *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. ").

However, the labels given to various actors, fields and sub-fields are not functionally related to the substrate of the article of manufacture. The labels themselves carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply a label to various actors, fields and sub-fields

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in a system such as Tomat because such data does not functionally relate to the substrate of the article of manufacture and merely labeling the data differently from that in the prior art would have been obvious. See *Gulack* cited above.

Alternatively, Claims 1-8 and 10-18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat (US 6,459,499) in view of Spiegel et al (US Patent 6,620,079).

As per claims 1, 4, 10, 16 and 25, Tomat discloses apparatus and methods for **Storing data in memory**. See for example, at least Col. 4, lines 47-58 and related Fig. 2. The data may be used for defining a first screen that includes multiple fields. See, for example, at least Fig. 10 and related text. The fields include parameter fields that contain data unique to a user, such as a user's name. The screen also includes additional fields, including a "Add/Edit" field for indicating, when selected by a user, the need to create an additional profile containing different parameters unique to the requesting user.

Generating and transmitting a first screen to a client via the communications system and (in claim 25) **providing** on a display associated with a user terminal a control screen including at least two profile fields unique to said user, each one including a credit card number sub-field, a ship-to address sub-field and bill-to address sub-field, an item sub-field listing items ordered by said user. See, for example, at least Fig. 10, which has been generated, transmitted and displayed on a client under the

control of the user. For communications system and network, please refer at least to Fig. 3 and related text.

Tomat discloses defining a control screen that includes at least two profile fields, and that each profile field may include at least two sub-fields. See, for example, at least Fig. 5 and related text. However, Tomat **does not** specifically disclose that each profile field may include:

- a credit card number sub-field,
- a ship to address sub-field and
- a bill-to address sub-field

wherein each sub-field is unique to the user and selectable by said user [added 31 January 23005].

Spiegel discloses displaying at least one profile field including billing information, shipping information. See, for example, Fig. 2, item 203 and related text. For credit card, please see at least Col. 2, lines 35-59. As noted, ***billing info:*** stands for ***billing information***. Billing information may include ***credit card information***, as in *Spiegel* Col. 2, lines 35-58. Credit card information may include ***credit card numbers***, as in Col. 2, lines 1-34. Thus ***Spiegel*** discloses that a control screen such as Fig. 2, may display various types of information, including credit card number according to a user's selection; this information is user-selectable since the user selects which profile to use.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to combine Tomat and *Spiegel* to disclose that each profile field may include:

- a credit card number sub-field,
- a ship to address sub-field and
- a bill-to address sub-field

wherein each sub-field is unique to the user and selectable by said user.

Oe of ordinary skill in the art the time the invention was made would have been motivated to combine Tomat and *Spiegel* to disclose that each profile field may include:

- a credit card number sub-field,
- a ship to address sub-field and
- a bill-to address sub-field

wherein each sub-field is unique to the user and selectable by said user for the obvious reason that by doing so, a user may conduct business in different roles and a user may select a profile that already has appropriate billing and shipping information. This makes it possible for a user to purchase certain types of videos using billing and shipping information that is different from billing and shipping information he would use for ordering in work-related products or otherproducts, as suggested by *Spiegel* in Col. 9, line 29-Col. 10, line 30.

selecting from displayed information the credit card number to be billed, mailing address to which items is to be shipped and mailing address to which bill is to be sent. See at least *Spiegel*, Fig. 2 and related text.

As per claims 2, 5, 11 and 17 Tomat discloses apparatus and methods whereby, in response to a request from a user for an additional profile, generates and transmits a second screen where a user may enter and input parameter data concerning an additional profile. See, for example, Fig. 6 and related text. The screen is generated, transmitted and displayed on a client over a communications network.

As per claims 3, 6, 12 and 18 Tomat discloses apparatus and methods, in response to the receipt of a completed second screen from a user, for updating stored

data defining the first screen and generating, transmitting and displaying the updated first screen that includes the stored data. See, for example, at least Fig. 10 and related text, which shows that Mr. Tanaka has two profiles.

As per claims 7 and 13, Tomat **does not** specifically disclose that each of the profiles includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action. *Spiegel* discloses a profile that includes a plurality of user-selectable fields, including "Check Out" "Finalize Now." See, for example, at least Fig. 2 and related text. These fields define unique actions such as checking out and finalizing.

As per claims 8 and 14, Tomat **does not** specifically disclose that the user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field. *Spiegel* discloses selectable fields for requesting an order entry (Fig. 1, button 103b, Fig. 2, fields 201(a) and 201(b). For edit, see Fig. 2, see field 303.

Response to Arguments

Rejection of claims 9 and 15 are moot in view of cancellation of said claims.

Objection to drawings 1-6 are removed in view of amendment.

Objections to claims 7, 10 and 13 are removed in view of amendment.

On page 13, line 20-page 14, line 3, Applicant argues:

...Applicant's objection in part is based upon the fact that the Examiner is introducing "shopping cart" in applicant's specification. This terminology was taken from ...[*Spiegel*]. Applicant sees no reason to introduce this language when –as argued herein—there is a clear distinction between the *Spiegel* reference and applicant's claimed invention.

In response to these comments, the Examiner respectfully directs applicant's attention to use of the term "shopping cart" in his application. For example,

- Fig. 2, "add to shopping cart", and paragraph 9 of applicant's specification.
- Fig. 7, "remove from shopping cart."
- Fig. 8, HTML code for Fig. 7, which reads, "Remove from shopping cart."

Therefore, applicant's arguments are not persuasive and the objection remains.

On page 14, lines 4-13, applicant argues

...Except for informalities in claims 7, 10 and 13 -now corrected- applicant respectfully disagrees with the Examiner. Applicant believes the claims comply with the Patent Office standard and practice and see no reason at this time to amend based upon informalities.

In fact, some of the Examiner's informalities seem to be the way the Examiner chooses to interpret the claim (broad or narrow). How could applicant amend the claim to affect the Examiner's interpretation is not clear. As a consequence, applicant elects to leave the claims as drafted relative to issues on informalities.

In response to these arguments, the Examiner respectfully notes that during prosecution, terms of the claim are given their broadest reasonable interpretation. The Examiner also notes that applicant has not pointed out any supposed errors with the Examiner's interpretation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner also notes that the claims are directed to various kinds of data and its presentation on a screen. For example, amended claim 1 contains the steps of

- Storing...data....
- Generating [a screen]
- Transmitting the generated ...screen

Other limitations are implied but are not actively recited and involved in the steps, and are outside of the metes and bounds of the claim. For example, the claim recites a field that, when selected by a user, indicates the need to create another field with

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different parameters. However, the content of these fields and parameters does not affect the steps of storing, generating and transmitting of claim 1.

The Examiner notes that presentation of data on a screen is old and well known and that data may be presented in a variety of formats on a user interface. Since the data has no function as claimed, the information is a compilation or mere arrangement of data. See MPEP 2106, pp. 2100-11 and 2100-12. The display of information is related to precedents dealing with printed matter, i.e., presentation of information in a form that is useful and intelligible only to the human mind. See *In re Gulack*, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate."). Protection for printed matter may be found under Copyright Law.

On page 15, lines 7-page 16, line 5, applicant argues, emphasis added:

It is applicant's contention that the prior art reference does not teach **a control screen including user-selectable credit card number**. A review of the references does not find this teaching or suggestion. It is noted the Examiner points to ... as supporting this feature [citation omitted]. However, applicant respectfully disagrees with the Examiner and argue that this section of **Spiegel** is referring to [...applicant's interpretation of **Spiegel**, a valid patent]...

Alternately, applicant argues that even if this was a suggestion relative to credit card use the information would be insufficient to teach an artisan how to solve this problem. It is applicant's contention that the prior art reference does not teach a control screen including user-selectable credit card number. A review of the references does not find this teaching or suggestion.

In response to these arguments, the Examiner respectfully directs applicant's attention to Fig. 2, item 203, which was also cited in the prior office action. Item 203 refers to **billing info**: This stands for **billing information**. **Spiegel** discloses that

billing information may include **credit card information**, as in Col. 2, lines 35-58.

Credit card information may include **credit card numbers**, as in Col. 2, lines 1-34.

Thus *Spiegel* discloses that a control screen such as Fig. 2, may display various types of information, including credit card information (such as credit card number) according to a user's selection; this information is user-selectable since the user selects which profile to use.

In response to applicant's argument that certain features are present in Tomat and *Spiegel*, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The Examiner cites particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

On page 16, line 6-page 17, line 7, applicant argues the novelty of his invention:

NOVEL ... SUGGEST UNOBVIOUSNESS

Due to the amendment set forth above, claims 7 and 8 (due to dependency) provide Due to the amendment set forth **novel** processes.... Likewise, claims 13 and 14 provide **novel** structures. As argued above and incorporated herein by reference the statement at **col. 2, lines 35-59** of *Spiegel* suggests a problem in the prior art which *Spiegel's* reference did not address....It should be noted that this problem is set forth in applicant's specification at page 4, lines 15-18....The problem is solved in applicant's invention by

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providing user-selectable credit card number which the user can select which credit card he wants a particular order to be charged to ... It is applicant's contention that solution of the problem together with *novel* process (claims 7-8) and *novel* structure claims (13-14) are indicia of nonobviousness.... As a consequence, claims 7-8 and 13-14 are patentable over the art of record.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

On page 17, lines 1-3, applicant argues that the material he attempts to introduce is not new matter. The Examiner respectfully disagrees. The cited text reads:

difficulties. The user must keep track of which account is which, and he will be unable to group his purchases to take advantage of volume discounts or rebates. [page 5, lines 1-2, emphasis added.] Applicant's reference to Col. 5, lines 1-2 appears to be an error, and will be interpreted to refer to **page** 5, lines 1-2.

However, applicant does not provide a solution to this observed problem and attempts to do so via this new matter. See also objections to new matter, *Specification*. The Examiner respectfully notes that Applicant has the burden of showing that a person of skill in the art "would have understood, at the time the patent application was filed, that the description **requires the limitation.**" *Hyatt*, 47USPQ 2d at 1131.

A "traverse" is a denial of an opposing party's allegations of fact.¹ The Examiner respectfully submits that applicants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to

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constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). MPEP 2144.03 Reliance on Common Knowledge in the Art or "Well Known" Prior Art. In view of applicant's failure to adequately traverse official notice, the following are admitted prior art::

... it would have been obvious to one of ordinary skill in the art the time the invention was made to combine Tomat and **Spiegel** to disclose that (claim 7) a profile includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action, (claim 8) that the user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field and (claim 9) that the unique parameters include credit card number sub-field, a ship to address sub-field and a bill to address sub-field.

One of ordinary skill in the art the time the invention was made to would have been motivated combine Tomat and **Spiegel** to disclose that (claim 7) a profile includes a plurality of user selectable sub-fields each of which when selected by the user defines a unique action, (claim 8) that the user selectable sub-fields include a first sub-field for requesting an order entry, a second user selectable sub-field requesting an edit of the unique parameters and a third user selectable sub-field requesting deletion of the profile field and (claim 9) that the unique parameters include credit card number sub-field, a ship to address sub-field and a bill to address sub-field for the obvious reason that by doing so, a user may conduct business in different roles and a user may select a profile that already has the appropriate billing and shipping information. This makes it possible for a user to purchase certain types of videos using billing and shipping information that is

¹ Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

different from billing and shipping information he would use for ordering in work-related products, as suggested by *Spiegel* in Col. 9, line 29-Col. 10, line 30.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JZ
James Zurita
Patent Examiner
Art Unit 3625
10 May 2005


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